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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/019,329

05/09/2002

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29177 7590 06/09/2008
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EXAMINER

TRAN, TUAN A

ART UNIT

PAPER NUMBER

2618

MAIL DATE

DELIVERY MODE

06/09/2008

PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte VOLKER DEICHMANN,
JOERG-MICHAEL HASEMANN, MARC PIETRIGA,
HOLGER SCHULZ, and GEORG SOFFEL

Appeal 2007-3622
Application 10/019,329¹
Technology Center 2600

Decided: June 9, 2008

Before ANITA PELLMAN GROSS, SCOTT R. BOALICK,
and KARL EASTHOM, *Administrative Patent Judges*.

BOALICK, *Administrative Patent Judge*.

¹ The real party in interest is Siemens AG.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the final rejection of claims 9-16, all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

STATEMENT OF THE CASE

Appellants' invention relates to a mobile phone having at least one electronic telephone directory, where one electronic telephone directory is stored on a SIM (Subscriber Identity Module) card and the other electronic telephone directories, if any, are stored in the nonvolatile memory of the phone. (Spec. 1: 22-26.)

Claim 9 is exemplary:

9. A mobile phone, comprising:

a nonvolatile memory;

an SIM card;

at least one electronic telephone directory, one of the at least one of the electronic telephone directory being stored in a memory of the SIM card and another of the at least one electronic telephone directory, if applicable, being stored in the non-volatile memory, a number of attributes including telephone numbers and names of the at least one telephone directory being prescribed by the SIM card; and

at least one database stored in the nonvolatile memory and, each of the at least one database being respectively assigned to one of the at least one electronic telephone directory,

wherein each entry of a telephone directory is assigned to a corresponding database entry having a data field of variable size with respect to a number of additional attributes assigned to the telephone directory entry.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Iwata	US 6,009,338	Dec. 28, 1999 (filed Apr. 17, 1997)
Holmstrom	WO 98/30053	Jul. 9, 1998

Claims 9-16 stand rejected under 35 U.S.C. § 103(a) as being obvious over Holmstrom and Iwata.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Briefs and the Answer for their respective details. Only those arguments actually made by Appellants have been considered in this decision. Arguments that Appellants did not make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).²

² Appellants have not presented any substantive arguments directed separately to the patentability of the dependent claims. In the absence of a separate argument with respect to those claims, they stand or fall with the representative independent claim. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ISSUE

The issue is whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 103(a). The issue turns on whether Holmstrom and Iwata teach or suggest the claimed limitation of "at least one database stored in the nonvolatile memory and, each of the at least one database being respectively assigned to one of the at least one electronic telephone directory, wherein each entry of a telephone directory is assigned to a corresponding database entry having a data field of variable size with respect to a number of additional attributes assigned to the telephone directory entry."

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. Holmstrom relates to a phone book of a mobile phone. (Holmstrom 1:4-5.) Holmstrom explains that the use of phone books on mobile phones is limited because, for complex operations, users must have detailed knowledge in order to use them. (Holmstrom 1:18-20.) The invention of Holmstrom is designed to enhance the use of phone books in mobile phones by simplifying the steps that a user must take in order to use complex operations, such as establishing a conference call. (Holmstrom 1:23-25.) In the phone book of Holmstrom, names and abbreviated numbers are stored either in a SIM card of the phone or in an EEPROM (nonvolatile memory) of the phone. (Holmstrom 2:25-28, 3:5-8.) Table 1 of Holmstrom shows names and numbers of

the phone book, and uses the presence or absence of a particular symbol next to the number in a given phone book entry in order to denote whether that entry is stored in the SIM card or stored in the EEPROM. (Holmstrom 2:27-28, 3:5-8.) Operations such as copy, erase, call, or conference call may be performed on selected phone book items. (Holmstrom 3:10-14, 4:1 to 5:9.)

2. Iwata relates to a mobile telephone, including the control and user interface of a mobile phone that combines mobile telephone and personal information management functions. (Iwata col. 1, ll. 6-16.) Iwata explains that it is aimed at overcoming problems in the prior art relating to ease of use, such as enabling a user to use an electronic word processor function while talking on the telephone. (Iwata col. 4, l. 41 to col. 5, l. 45.) The mobile phone of Iwata includes an address book, which is stored in RAM on the mobile phone. (Iwata col. 26, ll. 29-30.) Figure 6 of Iwata shows an example of a name list of the address book and Figure 7 shows an example of detailed information contained in the address book. (Iwata col. 9, ll. 22-29, col. 14, l. 4 to col. 5, l. 13.) When a particular name on the name list shown in Figure 6 is selected by the user, details about the selected name, such as home address, home phone, home fax, company name, department position, office address, office phone, and office fax, are displayed as shown in Figure 7. (Iwata col. 14, l. 64 to col. 15, l. 8.) In addition, Figure 30 shows an exemplary data format for the address book. (Iwata col. 26, ll. 29-40.) The address book data shown in Figure 30 corresponds to the address book screens shown in Figure 6 and 7.

(Iwata col. 26, ll. 32-34.) Some data fields shown in Figure 30 contain data, while others contain no data. The size of the data fields shown in Figure 30 varies depending upon the size of the data entry contained therein.

PRINCIPLES OF LAW

All timely filed evidence and properly presented arguments are considered by the Board in resolving an obviousness issue on appeal. *See In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984).

In the examination of a patent application, the Examiner bears the initial burden of showing a *prima facie* case of unpatentability. *Id.* at 1472. When that burden is met, the burden then shifts to the Applicant to rebut. *Id.*; *see also In re Harris*, 409 F.3d 1339, 1343-44 (Fed. Cir. 2005) (finding rebuttal evidence unpersuasive). If the Applicant produces rebuttal evidence of adequate weight, the *prima facie* case of unpatentability is dissipated. *In re Piasecki*, 745 F.2d at 1472. Thereafter, patentability is determined in view of the entire record. *Id.* However, on appeal to the Board it is the Appellant's burden to establish that the Examiner did not sustain the necessary burden and to show that the Examiner erred. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [for obviousness] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such

that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007).

In *KSR*, the Supreme Court reaffirmed that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* at 1739. The Court explained:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

Id. at 1740.

"[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d at 988. "To facilitate review, this analysis should be made explicit." *KSR*, 127 S. Ct. at 1741. However, "the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *Id.*

The Supreme Court noted that "[u]nder the correct analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed." *KSR*, 127 S. Ct. at 1742. The Court also noted that "[c]ommon sense teaches . . . that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle." *Id.* at 1742. "A person of ordinary skill is also a person of ordinary creativity, not an automaton." *Id.*

During examination of a patent application, a claim is given its broadest reasonable construction consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969). "[T]he words of a claim 'are generally given their ordinary and customary meaning.'" *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (internal citations omitted). The "ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application." *Id.* at 1313.

ANALYSIS

Appellants contend that the Examiner erred in rejecting claims 9-16 as being obvious over Holmstrom and Iwata. Reviewing the record before us, we do not agree. In particular, we find that the Appellants have not shown that the Examiner failed to make a prima facie showing of obviousness with respect to claims 9-16. Appellants failed to meet the burden of overcoming that prima facie showing.

Regarding claim 9, Appellants argue that one of ordinary skill in the art would not have been motivated to combine the teachings of Holmstrom and Iwata. (App. Br. 10-12; Reply Br. 2-3.) We do not agree.

As the Examiner correctly found (Ans. 4, 6), both Holmstrom and Iwata are directed to mobile phones having telephone directories. (FF 1, 2.) We agree with the Examiner (Ans. 4, 6) that it would have been obvious to one having ordinary skill in the art at the time of the invention to have applied the teachings of Iwata regarding expanded telephone directory information to the telephone directory stored in the nonvolatile memory (EEPROM) of the phone of Holmstrom in order to allow users to store additional information associated with the telephone directory. (FF 1, 2.) Such a combination would have been well within the level of ordinary skill in the art. Appellants have not presented, nor do we find, evidence to the contrary.

Although Appellants contend, among other things, that there is no motivation to combine because there is no SIM card teaching in Iwata and Iwata uses only a RAM memory implementation (App. Br. 11; Reply Br. 3), the teachings of a SIM card and nonvolatile memory are found in Holmstrom rather than in Iwata. (FF 1.) Appellants also argue that, because Holmstrom uses an "abbreviated directory," the expanded telephone directory of Iwata has no bearing because it does not further the stated objective of Holmstrom. (Reply Br. 3.) However, the motivation to combine need not be formulated as narrowly as Appellants assert. *See KSR*, 127 S. Ct. at 1741. As already discussed, we agree with the rationale articulated by the Examiner for combining Holmstrom and Iwata. In addition, to the extent that Appellants were referring to the abbreviated

telephone numbers listed in the phone book of Holmstrom (FF 1), one of ordinary skill in the art would have recognized that the same benefits could be achieved using full length telephone numbers. We do not find any functional difference in Holmstrom between using an abbreviated telephone number in the phone book or using a full length telephone number in the phone book.

Appellants further argue against the combination because some of the telephone entries in Holmstrom are "tagged" (i.e., preceded by a symbol indicating that they are stored in the nonvolatile memory (*see* FF 1)) while others are not (the absence of a symbol indicating that they are stored in the SIM card (*see* FF 1)) and, by contrast, all of the entries in Iwata are "tagged" (i.e., they are stored in RAM rather than a SIM card (*see* FF 2)). (App. Br. 10-11; Reply Br. 2-3.) However, we do not see this as an impediment to the combination of the teachings of Holmstrom and Iwata. The teachings of Iwata regarding expanded telephone directory entries that are stored in the internal memory of the phone (FF 2) apply at least to the "untagged" entries of Holmstrom that also are stored in the internal memory of the phone (FF 1). Moreover, it would have been no more than common sense to apply the teachings of Iwata regarding expanded telephone directory entries (FF 2) to the "tagged" entries of Holmstrom stored on the SIM card (FF 1).

Appellants next argue that Holmstrom and Iwata fail to teach or suggest the claimed limitation of "at least one database stored in the nonvolatile memory and, each of the at least one database being respectively assigned to one of the at least one electronic telephone directory, wherein each entry of a telephone directory is assigned to a corresponding database entry having a data field of variable size with respect to a number of

additional attributes assigned to the telephone directory entry." (App. Br. 13-14; Reply Br. 3-5.) We do not agree.

Holmstrom teaches a telephone directory stored on the SIM card and a telephone directory stored in the internal nonvolatile memory of the phone. (FF 1.) Iwata teaches a database (detailed information or "expansion telephone directory" of Figure 7) stored in the internal memory (RAM) of the phone (FF 2), and Holmstrom teaches that the internal phone memory may be nonvolatile (EEPROM) (FF 1). The claim recites "at least one database," so only a single database is required. Thus, the combined teachings of Holmstrom and Iwata meet the claimed limitation of "at least one database stored in the nonvolatile memory."

Iwata also teaches that the database (detailed information or "expansion telephone directory" of Figure 7) is assigned to an electronic telephone directory (name list of Figure 6) stored in the internal phone memory. (FF 2.) The claim recites "each of the at least one database being respectively assigned to one of the at least one electronic telephone directory." Where there are two electronic telephone directories (as taught by Holmstrom -- one stored on the SIM card and one stored in the internal nonvolatile memory of the phone) and one database (the detailed information or "expansion telephone directory" of Figure 7 of Iwata), the claim only requires that the database be assigned to one of the two directories. Thus, under a reasonable interpretation of the claim, the database may be assigned to the telephone directory stored in the internal phone memory (rather than being assigned to the directory stored on the SIM card). In addition, given the teachings of Holmstrom and Iwata, it would have been no more than common sense for one of ordinary skill in the

art to have assigned a telephone directory stored on the SIM card to a database in the internal phone memory storing additional telephone directory information.

Iwata further teaches that each entry in the telephone directory (shown in Figure 6) may be assigned to a corresponding expansion telephone directory (shown in Figure 7). (FF 2.) The size of the data field taught by Iwata is variable with respect to a number of additional attributes, including home address, company name, and office address (shown in Figure 30), which are assigned to the telephone directory entry because the data fields for the additional attributes may or may not contain additional data and the size of the additional data entries may vary. (FF 2.)

Thus, the combined teachings of Holmstrom and Iwata also meet the claimed limitation of "each of the at least one database being respectively assigned to one of the at least one electronic telephone directory, wherein each entry of a telephone directory is assigned to a corresponding database entry having a data field of variable size with respect to a number of additional attributes assigned to the telephone directory entry."

Appellants argue that the Examiner has misinterpreted the claim and that the database stored in the internal memory of the phone must be assigned to the telephone directory stored on the SIM card, not the telephone directory stored in the internal memory of the phone. (Reply Br. 3-5.) We do not agree.

The plain language of claim 9 requires that each entry of "*a* telephone directory" (emphasis added) be assigned to a corresponding database. However, the claim does not require that *each* telephone directory (i.e., the one stored on the SIM card and the one(s) stored in internal memory) be

assigned to a corresponding database. In other words, the claim does not require that the number of telephone directories match the number of databases. Neither does the claim specify *which* telephone directory must be assigned to a corresponding database if there is more than one telephone directory but only one database. Therefore, we find no error in the Examiner's reasoning (Ans. 4, 7) that the database may be assigned to the telephone directory stored in internal memory rather than the telephone directory stored in the SIM card.

Accordingly, we conclude that Appellants have not shown that the Examiner erred in rejecting independent claim 9 under 35 U.S.C. § 103(a). Dependent claims 10-16 were not argued separately, and fall together with independent claim 9.

CONCLUSION OF LAW

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 9-16.

DECISION

The rejection of claims 9-16 for obviousness under 35 U.S.C. § 103 is affirmed.

Appeal 2007-3622
Application 10/019,329

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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